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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/560,065

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Oskar Axelsson

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09/28/2010

GE HEALTHCARE, INC.

IP DEPARTMENT 101 CARNEGIE CENTER

PRINCETON, NJ 08540-6231

EXAMINER

SCHLIENTZ, LEAH H

ART UNIT

PAPER NUMBER

1618

MAIL DATE

DELIVERY MODE

09/28/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/560,065	Applicant(s) AXELSSON ET AL.	
	Examiner Leah Schlientz	Art Unit 1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-11, 13-21, 23-25, 27-30 and 39-53 is/are pending in the application.
- 4a) Of the above claim(s) 16, 28-30 and 44-53 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-11, 13-15, 17-21, 23-25, 27 and 39-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgement of Receipt

Applicant's Response, filed 7/15/2010, in reply to the Office Action mailed 3/18/2010, is acknowledged and has been entered. Claims 1-5, 7-11, 13-21, 23-25, 27-30 and 39-53 are pending, of which claims 16, 28-30 and 44-53 are withdrawn from consideration at this time as being drawn to a non-elected invention. Claims 1-5, 7-11, 13-15, 17-21, 23-25, 27 and 39-43 are readable upon the elected invention and are examined herein on the merits for patentability.

Response to Arguments

Any rejection not reiterated herein has been withdrawn.

Applicant's arguments have been fully considered, but are not persuasive for reasons set forth hereinbelow.

Double Patenting

Claims 1-5, 7-11, 13-15, 17-21, 23-25, 27 and 39-43 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the claims of copending Application No. 11/913,079 for reasons set forth in the previous Office Action.

Applicant requests on page 2 of the Response that this rejection be held in abeyance until the indication of allowable subject matter, and indicates that when

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patentable subject matter is found, Applicant will file a terminal disclaimer if necessary.

The rejection is maintained because a terminal disclaimer has not been received at this time.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 7-11, 13-15, 17-21, 23-25, 27 and 39-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guillet (US 2003/0177868) in view of Mao (US 6,686,308) for reasons set forth in the previous Office Action.

Applicant argues on pages 3-5 of the Response that the present invention relates to metallic tungsten nanoparticles for use as an X-ray contrast agent, and that Guillet relates to a method of preparing polymeric material in the form of a stable, substantially spherically nanoparticle. Particularly, Guillet is a reference teaching internally cross-linked, stable polymeric materials, in the form of substantially spherical particles, each particle consisting of essentially of a single macromolecule, having the unusual property of being soluble or dispersible in a liquid medium without significantly increasing the viscosity of the medium, rendering them potentially useful in imaging applications such as ink jet

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printers. The technical field is totally different from the development of new contrast agents for x-ray imaging. Applicant further argues that Guillet discloses a method for preparing nanoparticles of a metal, however, the process comprising four different steps recited in claim 17 are not similar to the process of preparing metallic tungsten particles according to the present invention. Applicant asserts that it is not obvious for a person skilled in the art to choose Guillet as a relevant prior art and as a starting point for development of new X-ray contrast agents since it does not disclose, teach, or even suggest the development of a new X-ray contrast agent. Mao et al. is related to a supported catalyst and list that typical catalyst metals are platinum, palladium, ruthenium, rhodium, iridium, osmium, molybdenum, tungsten, iron and nickel, which is all common general knowledge. The present invention is not related to supported catalysts. Applicant argues that one working in the field of X-ray contrast agents would not read Guillet and Mao as relevant prior art. Secondly, made aware of the references, Applicant would not have been motivated by the combined teaching of Guillet and Mao to come up with Applicant's claimed invention.

This is not found to be persuasive. With regard to the argument that Guillet and Mao are not directed to x-ray contrast agents, it is noted that claim 1 does not recite the function of the claimed particles. The claim merely states "a particle comprising a core of the metallic element tungsten, etc...". Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). With regard to claims 39-43, a recitation of

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the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. With regard to the argument that Guillet teaches a different method of making, it is noted that the instant claims are product claims, not "method of making" type claims.

Claims 1, 7-10, 13-15, 20, 21, 23-25, 27 and 39-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rioux *et al.* (US 2004/0101564), for reasons set forth in the previous Office Action.

Applicant argues on pages 5-6 of the Response that Rioux *et al.* is related to a particle comprising a polymeric matrix and a ferromagnetic material distributed in the polymeric matrix. Applicant argues that the particle according to the present invention is a totally different particle defined by a core of metallic tungsten with a charged coating layer to passivate the reactive surface of the tungsten particle, said coating layer comprising a polymeric layer formed from acrylic acid monomers. It is not a particle wherein the radiopaque material is distributed in the polymeric matrix. By reading Rioux, Applicant would not have been motivated to pick tungsten from the list and come up with the Applicants claimed invention.

This is not found to be persuasive. The instantly rejected claims are very broad, with no limitation on particle size, coating thickness, etc. Rioux teaches particles that include a radiopaque material. Given the broadest reasonable

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interpretation, an individual micron-sized radiopaque material 14 (e.g. tungsten) within a matrix can be considered a particle “core,” which is “coated” by the matrix material 12 (e.g. polyacrylic acid).

Conclusion

No claims are allowed at this time.

Although Applicant’s arguments as set forth in the aforementioned Response have been fully considered, they are deemed unpersuasive. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leah Schlientz whose telephone number is (571)272-9928. The examiner can normally be reached on Monday-Tuesday and Thursday-Friday 9 AM-5 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley can be reached on 571-272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael G. Hartley/
Supervisory Patent Examiner, Art Unit 1618

LHS